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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,582	02/06/2002	Jurgen Hoffmann	016790-0455	5464
22428	7590	01/13/2005	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			LUU, THANH X	
			ART UNIT	PAPER NUMBER
			2878	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/066,582

Applicant(s)

HOFFMANN, JURGEN

Examiner

Thanh X. Luu

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,7,8,10,12,14,16,17 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) 16,23-25 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7,8,10,12,14,17,19-22,26 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 112004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 18, 2004 has been entered.

Claims 1-3, 7, 8, 10, 12, 14, 16, 17 and 19-28 are currently pending. Claims 16, 23-25 and 27 are withdrawn.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 7, 12, 14, 17, 26 and 28, are rejected under 35 U.S.C. 102(e) as being anticipated by Dorsel et al. (U.S. Patent 6,320,196).

Regarding claims 1-3, 7, 12, 14, 17, 26 and 28, Dorsel et al. disclose (see Fig. 1) a scanning microscope system, comprising: a scanning microscope comprising: a light source (35, 40) that emits an exciting light beam which is suitable for exciting an energy

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state in a specimen and that emits a stimulating light beam configured for generating stimulating emission in the specimen, whereby the exciting light beam and the stimulating light beam overlap in a focal region (at 55) at least partially; and at least one detector (90, 95) configured for detection of emitted light proceeding from the specimen; and a module (66) that is positionable in a beam path of the scanning microscope and that comprises multiple optical elements (60, 65), pre-aligned with respect to each other, which shape the stimulating light beam, and wherein the module is adjustable (see arrows in Fig. 1) with respect to the scanning microscope. Dorsel et al. also disclose (see Fig. 1) the module comprises a housing; the module's perimeter inherently acts as an alignment device as claimed; the module comprises optics for focusing (65) or means for influencing (65) the shape of the focus of the stimulating light beam.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Kashima et al. or Dorsel et al.

Regarding claims 8, 19 and 22, Kashima et al. and Dorsel et al. disclose the claimed invention as set forth above. Kashima et al. and Dorsel et al. do not specifically disclose a retardation plate. However, retardation plates are notoriously well known in the art to adjust the polarization of a beam as desired. It would have been obvious to a

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person of ordinary skill in the art at the time the invention was made to provide a retardation plate in the apparatus of Kashima et al. or Dorsel et al. to obtain a specific polarization of an input beam for improved detection.

Regarding claim 21, Kashima et al. and Dorsel et al. disclose the claimed invention as set forth above. Kashima et al. and Dorsel et al. do not specifically disclose a liquid crystal array as claimed. However, it is well known that liquid crystal arrays provide adjustable degrees retardation. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made use a liquid crystal array in the apparatus of Kashima et al. or Dorsel et al. to obtain more configurable retardation.

#### ***Allowable Subject Matter***

6. Claims 10 and 20 are allowed over the prior art of record.

#### ***Response to Arguments***

7. Applicant's arguments filed November 18, 2004 have been fully considered but they are not persuasive.

Applicant asserts that a lens does not "influence the shape of the focus of the stimulating light beam in a focal region" because the shape of the focus does not change with the lens. However, changing the shape of the focus is not claimed. Applicant simply claims the shape of the focus is influenced by a means or an optical element. As understood, a lens influences the shape of the focus of a beam because it actually serves to focus the beam to a focal point.

Applicant also asserts that a retardation plate is not desired in the prior art because the retardation plate in the invention is required to be rearranged so that it is transilluminated by a central portion of the beam and be located in a Fourier plane. However, no such language is found in the claims.

Thus, as set forth above, this rejection is proper.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X. Luu whose telephone number is 571-272-2441. The examiner can normally be reached on M-F 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on 571-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thanh X Luu  
Primary Examiner  
Art Unit 2878